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| 09/732,333      | 12/06/2000  | Roger D. Pirkey      | 10942/269227        | 1489             |

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| EXAMINER |
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PYZOCHA, MICHAEL J

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| ART UNIT | PAPER NUMBER |
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2137

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 12/21/2006 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/732,333

Applicant(s)

PIRKEY ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

1. Claims 1, 2, 4-6, 9, 11-13, 16, 17, 19-21, 24, 26-28 and 31-42 are pending.
2. Response filed 11/21/2006 has been received and considered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2, 4, 6, 9, 11, 13, 16-17, 19, 21, 24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al. (US 6134447) in view of Rosenthal et al. (US 5737701).

Referring to claims 1, 9, 16 and 24, Havinis et al. discloses concurrently maintaining a system-wide list associated with a plurality of subscribers and a separate and distinct plurality of lists associated with the subscribers; receiving a request for a resource (see column 4 lines 19-52, column 5 line 45 through column 6 line 55); first checking the system wide

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list; if the resource is included in the system wide list providing or denying access to the resource in accordance with the system wide list and if the resource is no on the system wide list retrieving and comparing the subscriber list and allowing access if he resource is included in the list associated with the subscriber (see figure 4 and correspond description in columns 5 and 6).

Havinis et al. fails to disclose the requirement of inputting a PIN if the subscriber is not on the list.

However, Rosenthal et al. teaches requiring the subscriber to input a personal identification number if the resource is not included in the list associated with the subscriber and providing access to the resource if the subscriber inputs the correct personal identification number (see column 5 lines 35-67, column 6 lines 1-38, 63-67, column 7 lines 1-9).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to require the use of a PIN in the Havinis et al. system.

Motivation to do so would have been help prevent fraud in the system (see Rosenthal column 2 line 60 through column 3 line 2).

As per claims 2 and 17, the modified Havinis et al. and Rosenthal et al. system discloses the claimed limitation wherein

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comprising the step of adding the resource to the list associated with the subscriber if the subscriber inputs the correct personal identification number (see Rosenthal et al Column 7, lines 10-22).

As per claims 4, 11, 19 and 26, the modified Havinis et al. and Rosenthal et al. system discloses an always deny list (see Havinis et al. column 4 lines 41-52).

As per claims 6, 13, 21, and 28, the modified Havinis et al. and Rosenthal et al. system discloses the claimed limitation wherein the resource is a telephone connection to a destination phone number (see Rosenthal et al Column 6, lines 5-9).

5. Claims 5, 12, 20, 27, 33, 36, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 1, 9, 16, and 24 above, and further in view of Mijares Jr. et al (US 6330311).

As per claims 5, 12, 20, 27, 33, 36, 39, and 42, the modified Havinis et al. and Rosenthal et al. system fails to disclose an always require PIN list for numbers associated with 900 or international calls.

However Mijares Jr. et al teaches such a list (see column 9 lines 10-43).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Mijares Jr. et al.'s always require PIN list for 900 or international calls in the call restricting method of the modified Havinis et al. and Rosenthal et al. system.

Motivation to do so would have been to allow a user to call the blocked 900 or international numbers (see Mijares Jr. et al column 9 lines 37-43).

6. Claims 31, 34, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 1, 9, 16 and 24 above, and further in view of Rowell et al (WO 9704602).

As per claims 31, 34, 37, and 40, the modified Havinis et al. and Rosenthal et al. system fails to disclose the always allow list comprises a phone number associated with emergency services

However Rowell teaches such a list (see Rowell page 3 lines 3-11).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include emergency numbers on the always allow list of the modified Havinis et al. and Rosenthal et al. system.

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Motivation to do so would have been to always let emergency numbers be called (see page 3 lines 3-11).

7. Claims 32, 35, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 4, 11, 19, and 26 above, and further in view of Rudokas et al (US 5420910).

As per claims 32, 35, 38 and 41, the modified Havinis et al. and Rosenthal et al. system fails to disclose the always deny list comprises a phone number associated with fraudulent use.

However, Rudokas et al teaches such a list of fraudulent numbers (see column 5 line 59 through column 6 line 14).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Rudokas et al's method of preventing fraudulent numbers from being called in the call restricting service of the modified Havinis et al. and Rosenthal et al. system.

Motivation to do so would have been prevent cloned identification systems from making calls to fraudulent numbers (see Rudokas et al column 5 line 59 through column 6 line 14).

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***Response to Arguments***

8. Applicant's arguments filed 11/21/2006 have been fully considered but they are not persuasive. Applicant argues: Havinis fails to teach or suggest checking or maintaining a system-wide list regardless of subscriber identity concurrently with distinct and separate lists associated with subscribers; Havinis fails to disclose the progression of comparison as disclosed by the claims; the combined references fail to disclose providing or denying access to a resource based on lists and a PIN; and Rosenthal fails to teach the step of adding the resource to a list described in claim 2.

With respect to Applicant's argument that Havinis fails to teach or suggest checking or maintaining a system-wide list regardless of subscriber identity concurrently with distinct and separate lists associated with subscribers, Havinis teaches the use of a black list with more than one LA included in the list (see column 4 lines 61-63) therefore this list is not associated with any specific subscriber and further more column 4 lines 34-40 describes how each LA is associated with a group of subscribers, therefore the black list is a system-wide list associated with a plurality of subscribers regardless of subscriber identity. Also this list is held concurrently with distinct and separate lists associated with the subscribers



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(i.e. the subscriber's profile) as described in columns 5 and 6. Column 4 line 61 through column 5 line 3 describes how the black list and the profiles are separate lists held concurrently.

With respect to Applicant's argument that Havinis fails to disclose the progression of comparison as disclosed by the claims Havinis first checks whether the requesting LA is in a black or gray list (the system-wide list) (see Fig. 4 numbers 405 and 410) and if it is not in either list it checks the specific profile (the subscriber specific list) (se Fig. 4 numbers 430 and 445). Therefore, Havinis teaches the progression of comparison disclosed by the claims. Furthermore, the combined reference of Rosenthal teaches comparing the requested resource to a list so again the combination teaches the claimed limitations.

With respect to Applicant's argument that the combined references fail to disclose providing or denying access to a resource based on lists and a PIN, Havinis teaches that if the LA is in the black list it is sent a rejection message thereby denying access to the resource (see Fig 4 numbers 405 and 420) and if the subscriber specific profile does not allow the resource it is again sent a rejection message (see Fig 4 numbers 445 and 420). Rosenthal teaches if a resource is not on a list to prompt a user for a PIN and if the PIN is valid allow the resource to be called and if not terminate the call thereby

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rejecting the resource. Therefore, the combination of Havinis and Rosenthal teaches that providing or denying access to a resource based on lists and a PIN.

With respect to Applicant's argument that Rosenthal fails to teach the step of adding the resource to a list described in claim 2 based on the cited portion not being relevant the situation when a PIN is entered. However, as disclosed by Rosenthal column 7 lines 6-10, the cited adding (column 7 lines 10-22) is done both when the number is in the automatic authentication database and when a valid PIN number is entered. Therefore, Rosenthal teaches the limitations of claim 2.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MJP

  
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SUPERVISORY PATENT EXAMINER